

DOCKET NO: 203577US



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
SHINICHI HIRATA : EXAMINER: SONG, H.  
SERIAL NO: 09/059,765 :  
RCE FILED: JUNE 13, 2003 : GROUP ART UNIT: 2135  
FOR: REMOTE CONTROL OF VCR :  
WITH ELECTRONIC MAIL :

**PETITION UNDER 37 CFR §1.181(a)(3)**

COMMISSIONER FOR PATENTS  
Alexandria, Virginia 22313

SIR:

This is a Petition pursuant to 37 CFR §1.181(a)(3) requesting that the examiner be provided the Application file in order to supply Applicants a copy of the below noted Form PTO-1449 that indicates consideration of the reference listed thereon.

**STATEMENT OF FACTS**

On January 18, 2000, Information Disclosure Statement (IDS) papers were mailed by the previous attorneys, the Limbach firm, that included a Form PTO-1449 listing a Japanese reference for consideration by the examiner as documented by the attached copy of these IDS papers including the Form PTO-1449 and the associated date-stamped filing receipt.

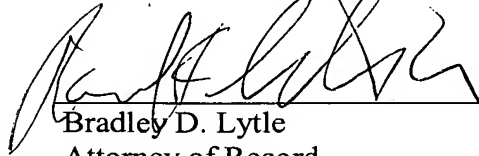
Upon review of this application after the allowance thereof, it was noted that there was no indication of receipt or consideration of the above-noted Form PTO 1449 listed Japanese reference.

ACTION REQUESTED

It is respectfully requested that the Examiner be supplied with the application file so that he can provide Applicant a copy of the above-noted Form PTO-1449 indicating proper consideration of the listed Japanese reference.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Customer Number  
**22850**

Tel: (703) 413-3000  
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(OSMMN 06/04)

Raymond F. Cardillo, Jr.  
Registration No. 40,440



Serial/Patent/Reg. No. 09/059,765 L&L File No. Sony-P8407 By CLH/dam  
In the Matter of the Application of: Shinichi Horata  
Title/Mark: Transmitting/Receiving Apparatus  
Date Mailed: 1/18/2000 Date Filed: \_\_\_\_\_

The following has been received in the U.S. Patent and Trademark Office on the date stamped hereon:

<input type="checkbox"/> Transmittal Letter	<input type="checkbox"/> Trademark (Use) Appln., Drawing and _____ Specimens
<input type="checkbox"/> Patent Application _____	<input type="checkbox"/> ITU Trademark Application and Drawing
<input type="checkbox"/> _____ pgs. specification including _____ pgs. claims	<input type="checkbox"/> _____ Request for Extension of Time (trademark)
Drawings _____ sheets _____ formal _____ informal	(Notice of Allowance: _____)
<input checked="" type="checkbox"/> Oath/Declaration	<input type="checkbox"/> Statement of Use/Amendment to Allege Use
<input type="checkbox"/> Assignment w/ Form PTO-1595	<input type="checkbox"/> Section 8 & 15 Declaration
<input type="checkbox"/> Power of Attorney	<input type="checkbox"/> Trademark Renewal Application and _____ Specimen
<input type="checkbox"/> Small Entity Declaration	<input type="checkbox"/> Opposition to _____
<input checked="" type="checkbox"/> Deposit Account Authorization (in duplicate)	<input type="checkbox"/> Petition for Cancellation
<input checked="" type="checkbox"/> Information Disclosure Statement, PTO-1449 w/ <u>1</u> references <input checked="" type="checkbox"/>	<input type="checkbox"/> Certificate of Mailing
<input type="checkbox"/> Check \$ _____	<input type="checkbox"/> Express Mail Certificate No. _____
<input type="checkbox"/> Amendment/Response	<input type="checkbox"/> Certificate under §3.73(b)
<input type="checkbox"/> Request for Extension of Time (____ months)(patent)	<input type="checkbox"/> Certificate of Correction (PTO Form 1050) _____
<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Petition for _____
<input type="checkbox"/> Notice of Appeal	<input checked="" type="checkbox"/> Other: _____
<input type="checkbox"/> Appeal Brief (in triplicate)	
<input type="checkbox"/> Letter to Official Draftsman	
<input type="checkbox"/> Issue Fee Transmittal	
<input type="checkbox"/> Maintenance Fee Transmittal	
<input type="checkbox"/> Request for _____	

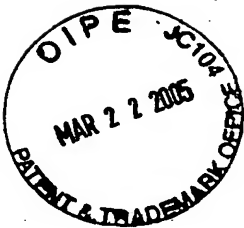
JAN 24 2000



Serial/Patent/Reg. No. 09/059,765 L&L File No. Sony-P8407 By: CLH/dam  
In the Matter of the Application of: Shinichi Horata  
Title/Mark: Transmitting/Receiving Apparatus  
Date Mailed: 1/18/2000 Date Filed: \_\_\_\_\_

The following has been received in the U.S. Patent and Trademark Office on the date stamped hereon:

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<input type="checkbox"/> Patent Application _____	<input type="checkbox"/> ITU Trademark Application and Drawing
<input type="checkbox"/> _____ pgs. specification including _____ pgs. claims	<input type="checkbox"/> _____ Request for Extension of Time (trademark)
<input type="checkbox"/> Drawings _____ sheets _____ formal _____ informal.	<input type="checkbox"/> (Notice of Allowance: _____)
<input type="checkbox"/> Oath/Declaration	<input type="checkbox"/> Statement of Use/Amendment to Allege Use
<input type="checkbox"/> Assignment w/ Form PTO-1595	<input type="checkbox"/> Section 8 & 15 Declaration
<input type="checkbox"/> Power of Attorney	<input type="checkbox"/> Trademark Renewal Application and _____ Specimen
<input type="checkbox"/> Small Entity Declaration	<input type="checkbox"/> Opposition to _____
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<input checked="" type="checkbox"/> Information Disclosure Statement, PTO-1449 w/ <u>1</u> references <input checked="" type="checkbox"/>	<input type="checkbox"/> Certificate of Mailing
<input type="checkbox"/> Check \$ _____	<input type="checkbox"/> Express Mail Certificate No. _____
<input type="checkbox"/> Amendment/Response	<input type="checkbox"/> Certificate under §3.73(b).
<input type="checkbox"/> Request for Extension of Time (____ months)(patent).	<input type="checkbox"/> Certificate of Correction (PTO Form 1050)
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<input type="checkbox"/> Letter to Official Draftsman	_____
<input type="checkbox"/> Issue Fee Transmittal	_____
<input type="checkbox"/> Maintenance Fee Transmittal	_____
<input type="checkbox"/> Request for _____	_____



PATENT

-1-

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	Group Art Unit: 2766
	)	
SHINICHI HIRATA	)	Examiner: Not Assigned
	)	
Application No. 09/059,765	)	<u>INFORMATION DISCLOSURE</u>
	)	<u>STATEMENT</u>
Filed: April 14, 1998	)	
	)	2001 Ferry Building
For: A TRANSMITTING/RECEIVING	)	San Francisco, CA 94111
APPARATUS AND A	)	(415) 433-4150
TRANSMITTING/RECEIVING	)	
METHOD	)	Atty. Docket No. SONY-P8407

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on January 18, 2000.

LIMBACH & LIMBACH L.L.P. Date: January 18, 2000

By: Deborah A. Mojarro  
Name: Deborah A. Mojarro

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Applicant submits herewith patents, publications or other information [attached hereto and listed on the attached Form PTO-1449 (modified)] of which he is aware, which he believes may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR § 1.56.

**This Information Disclosure Statement:**

- (a) ☐ accompanies the new patent application submitted herewith. 37 CFR § 1.97(a).
- (b) ☐ is filed within three months after the filing date of the application or within three months after the date of entry of the national stage of a PCT application as set forth in 37 CFR § 1.491.

- (c) ☒ as far as is known to the undersigned, is filed before the mailing date of a first Office Action on the merits.
- (d) ☐ is filed after the first office action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final rejection or a notice of allowance, whichever occurs first, and is accompanied by either the fee (\$240) set forth in 37 CFR § 1.17(p) or a certification as specified in 37 CFR § 1.97(e), as checked below.
- (e) ☐ is filed after the mailing date of either a final rejection or a notice of allowance, whichever occurred first, and the Issue Fee has not been paid, and is accompanied by the fee (\$130) set forth in 37 CFR § 1.17(i)(1) and a certification as specified in 37 CFR § 1.97(e), as checked below. This document is to be considered as a petition requesting consideration of the information disclosure statement.

[If either of boxes (d) or (e) are checked above, the following "certification" under 37 CFR § 1.97(e) may need to be completed.] The undersigned certifies that:

- (f) ☐ Each item of information contained in the information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.
- (g) ☐ No item of information contained in this information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this information disclosure statement.

A list of the patent(s) or publication(s) is set forth on the attached Form PTO-1449 (Modified).

A copy of the items on PTO-1449 (Modified) is supplied herewith:

- (h) ☒ each (i) ☐ none (j) ☐ only those listed below:

Those patent(s) or publication(s) which are marked with an asterisk (\*) in the attached form PTO-1449 (Modified) are not supplied because they were previously cited by or submitted to the Office in a prior application no. , filed and relied upon in this application for an earlier filing date under 35 U.S.C. § 120.

A concise explanation of relevance of the items listed on form PTO-1449 (Modified) is:

- (k) ☐ not given
- (l) ☐ given for each listed item
- (m) ☒ given for only non-English language listed item(s)  
[Required]
- (n) ☐ is in the form of an English language copy of a Search Report from a foreign patent office, issued in a counterpart application, which refers to the relevant portions of the references [copy attached].

**The explanation of relevance of the non-English language document listed on the form PTO-1449 is found in the English language abstract submitted concurrently.** The Examiner is reminded that a "concise explanation of the relevance" of the submitted items "may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention," MPEP § 609.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR § 1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR § 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR § 1.56(a) exists. It is submitted that the Information Disclosure Statement is in

compliance with 37 CFR § 1.98 and MPEP § 609 and the Examiner is respectfully requested to consider the listed references.

[x] The Commissioner is hereby authorized to charge our Deposit Account No. 12-1420 for any fees required in connection with the filing of this Information Disclosure Statement. **A duplicate copy of this Notice is enclosed for this purpose.** In particular, in the event that an Office Action has crossed in the mail with this Information Disclosure Statement, the Commissioner is authorized to charge the above-named deposit account for any fees required pursuant to CFR §§ 1.17(p) or 1.17(i)(1).

Respectfully submitted,

LIMBACH & LIMBACH L.L.P.

Dated: 18 Jan 00

By:

Charles L. Hamilton

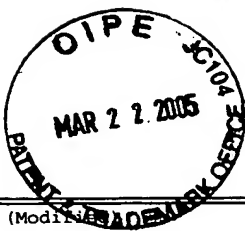
Charles L. Hamilton

Reg. No. 42,624

Tel. No. 415/433-4150

Our File: SONY-P8407



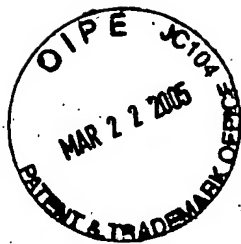


**PATENT**

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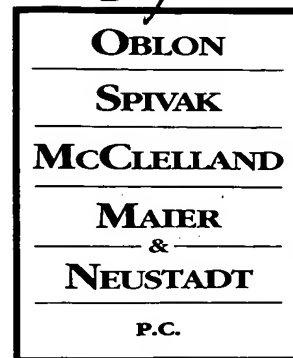
Sheet 1 of 1

FORM PTO-1449 (Modified) (Rev. 7-80)		U.S. Dept. of Commerce Patent and Trademark Office		Atty Docket No. SONY-P8407		Appln. No. 09/059,765	
INFORMATION DISCLOSURE CITATION  (Use several sheets if necessary)				Applicant(s) SHINICHI HIRATA			
				Filing Date April 14, 1998		Group 2766	
U.S. PATENT DOCUMENTS							
*Examiner Initials		Document Number	Date	Name	Class	Subclass	Filing Date
FOREIGN PATENT DOCUMENTS							
*Examiner Initials		Document Number	Date	Country	Class	Subclass	Translation YES NO
	AA	10-261251	9/29/98	JAPAN	G11B	15/02	ABSTR
OTHER DOCUMENTS							
Examiner				Date Considered			
* Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							



Docket No.: 203577US6  
Date Allowed: 02/15/05

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

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RE: Application Serial No.: 09/059,765

Applicants: Shinichi HIRATA

Filing Date: April 14, 1998

For: REMOTE CONTROL OF VCR WITH ELECTRONIC  
MAIL

Group Art Unit: 2135

Examiner: SONG, H.K.

SIR:

Attached hereto for filing are the following papers:

**PETITION UNDER 37 CFR §1.181 (a)(3)  
COPY OF FILED INFORMATION DISCLOSURE STATEMENT  
AND DATE-STAMPED FILING RECEIPT**

Our check in the amount of \_\_\_\_\_ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Bradley D. Lytle

Registration No. 40,073

Attorney of Record

Raymond F. Cardillo, Jr.

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Customer Number

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